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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,617	12/08/2003	X. Shawn Yu	Haworth C-205D	4027
30720	7590	06/30/2004	EXAMINER	
FLYNN, THIEL, BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008			SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,617	YU ET AL.	
	Examiner	Art Unit	
	M. Safavi	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on December 08, 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 24, "said opposite ends of said base panel" lacks antecedent basis within the claim as does "said base panel". Lines 30-31, "the other said first channel" lacks antecedent basis within the claim. Line 34, "said base panels" lacks antecedent basis within the claim. Line 39, "said base panel" lacks antecedent basis within the claim.

Claim 4 introduces a "box-like cross beam" at line 3 thereof then proceeds to recite "said box-beam" at line 11. See also, line 2 of claim 6. Should "said box-beam" of line 11 in claim 4, (and line 2 of claim 6), read –said box-like cross beam- or –said cross beam-?

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 and 4-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 4-11 of prior U.S. Patent No. 5,852,904. This is a double patenting rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-17, 20, and 21 of U. S. Patent No. 5,852,904 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

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common subject matter, as follows: As to claims 1-13: A space-dividing panel or panel system having upright wall panels formed of frames with vertical upright frame members and horizontal frame members with the horizontal members possessing a width between laterally extending side surfaces thereof which is greater than the width of the upright frame members with an elongate channel cross member having opposite first and second open ends, the channel cross member in alignment with a channel cross member of an adjacent wall panel with the open ends aligned to allow communication between serially connected wall panels to define a continuous uninterrupted first track extending between wall panels and with a connector assembly having mounting means for mounting a workstation component to the wall panel with means to connect the connector assembly to the first track of the base panel, the connector means having a hook-like member slidably engaged with the first channel and being slidable between serially-adjacent base panels along the first track.

As to claims 14-20: A space-dividing upright wall panel disposed in a load-bearing relation with a floor having a pair of laterally spaced apart vertical uprights defining opposite ends of said wall panel, each said upright having outward facing side surfaces on opposite sides thereof which define a width of said uprights with at least one box-like cross beam extending laterally between the uprights and having opposite ends rigidly connected to said uprights, the cross beam having a vertically enlarged height defined by upper and lower walls thereof which is a substantial portion of a vertical height of said uprights, and a width defined by vertically enlarged side faces on opposite sides thereof which face outwardly and extend vertically between said upper and lower walls

with the side faces being spaced outwardly from said side surfaces of the uprights such that the width of said cross beam is greater than the width of said uprights; a first cross member connected between said uprights a vertically spaced distance from said cross beam, and a horizontal first raceway being defined by an open interior of said wall panel which is formed vertically between said first cross member and said cross beam and extends laterally between said uprights, the frame of said wall panel being defined by said uprights, cross beam and first cross member, and at least one cover panel covering said horizontal raceway on one side thereof with the cover panel being connected to said frame by mounting means mounting said cover panel in an outwardly spaced relation from said side surfaces of said uprights to define passages, and with each passage being defined between said upright side surface and an opposing inward facing surface of the cover panel; said passages opening laterally from said opposite end of said wall panel such that said first raceway opens laterally from said opposite ends of said wall panel through said respective passages.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 14-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-21 of U.S. Patent No. 5,852,904. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because it would have been obvious to one having ordinary skill in the wall panel art to have the cover panel adapted to cover the horizontal raceway on one side of the wall panel if the cover panel covers the horizontal raceway on one side of the wall panel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2481.

The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. Safavi
June 20, 2004

MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354